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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH D. SIMONE JR.

Appeal 2008-004865
Application 09/658,298¹
Technology Center 2400

Decided:² July 2, 2009

Before JOHN C. MARTIN, HOWARD B. BLANKENSHIP, and JEAN R.
HOMERE, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Filed on September 8, 2000. The real party in interest is Coral Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 10, 12, and 14. Claims 11 and 13 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellant's Invention

Appellant invented a method and computer-readable medium that facilitates the automated processing of multiple items of data in a manner which reduces the level of human involvement. (Spec. 5, ll. 2-5.) In particular, project definitions are utilized to maintain and process computer files containing numerous images of items available for sale in a product catalog. (Spec. 14, ll. 25-32.) In order to ensure general conformity of images from various sources, each image is processed to adjust its respective size, shape, resolution, and tint. (Spec. 15, ll. 7-12.) As depicted in Figure 1, the project definition (14) obtains an image from subdirectory (12). (Spec. 10, ll. 1-6.) The image is outputted (22) by source module (21) to an input port of branch module (26). (Spec. 10, ll. 23-24.) Branch module (26) checks the size of the file associated with each image. (Spec. 10, ll. 24-26.) Depending on the size of the image, branch module (26) either: 1) outputs the image through an output port (27) to an input port of action module (31); or 2) outputs the image through an output port (28) to an input port of action module (32). (Spec. 10, ll. 27-33.) Both action modules (31, 32) have additional input ports that receive a text string containing the file associated with each image (23). (Spec. 11, ll. 1-6.) The action modules (31, 32) superimpose the text string (23) on the associated image data and output the results (33, 34) through an output port to an input port of respective

destination modules (37, 38). (Spec. 11, ll. 6-13.) After executing the projection definition (14), and in response to a predefined condition, an electronic mail message is transmitted to a remote device. (Spec. 56, ll. 16-34.)

Illustrative Claim

Independent claim 1 further illustrates the invention as follows:

1. A method, comprising the steps of:

providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for editing image data;

storing a project definition that is operable when executed to edit said image data and which includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;

executing said project definition; and

automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition, wherein transmitting said communication occurs after editing a predetermined number of images.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatenability:

Ferrel	US 5,907,837	May 25, 1999
Belanger	US 6,628,824 B1	Sep. 30, 2003

David Hollingsworth, *Workflow Management Coalition, The Workflow Reference Model*, Document Number TC00-1003, 1-55 (1995).

*Rejection on Appeal*³

The Examiner rejects the claims on appeal as follows:

Claims 1 through 10, 12, and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Hollingsworth, Ferrel, and Belanger.

Appellant's Contentions

1. Appellant contends that the Examiner erred in concluding that the combination of Hollingsworth, Ferrel, and Balenger renders independent claim 1 unpatentable. In particular, Appellant argues that:

a) Hollingsworth's disclosure of process definitions fails to teach the claimed set of predetermined function definitions. (App. Br. 15; Reply Br. 3-4.)

b) Ferrel's disclosure of an image editor used to create and modify images fails to teach at least one of said predetermined function definitions defining a function for editing image data. (App. Br. 15-16.)

c) Belanger's disclosure of an alarm or notification utilized, when comparing images using pattern matching, fails to teach transmitting said communication to a remote device wherein said communication occurs after editing a predetermined number of images. (App. Br. 17-18; Reply Br. 4.)

³ The Examiner withdrew the final rejection of claim 1 as being directed to non-statutory subject matter under 35 U.S.C. § 101. (Ans. 3.)

d) There is no motivation for the proffered combination. (App. Br. 19-21; Reply Br. 5-6.)

e) Ferrell is non-analogous art and cannot be properly used in the proffered combination. (App. Br. 21; Reply Br. 6-7.)

Examiner's Findings and Conclusions

1. The Examiner concludes that the combination of Hollingsworth, Ferrel, and Balenger renders independent claim 1 unpatentable. In particular, the Examiner finds that:

a) Hollingsworth's disclosure of process definitions executed on a computer teaches predetermined function definitions. (Ans. 10-12.)

b) Ferrel's disclosure of an image editor that creates and modifies image content teaches at least one of said predetermined function definitions defining a function for editing image data. (Ans. 12-14.)

c) Ferrel's disclosure of creating, editing, releasing, and storing images in a public storage teaches transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition. (Ans. 14-15.) Further, the Examiner finds that Belanger's disclosure of providing an alarm or notification based upon the occurrence of a particular event, in conjunction with Ferrel's disclosure of creating, editing, releasing, and storing images in a public storage, teaches wherein said communication occurs after editing a predetermined number of images. (Ans. 15-16.)

d) Hollingsworth's disclosure of automated image processing via process definitions, Ferrel's disclosure of an image editor, and Belanger's alarm or notification feature conditioned upon the occurrence of a particular

event provides a record of objective evidence that teaches motivation for the proffered combination. (Ans. 17-20.)

e) Ferrel is analogous art because it falls within Appellant's field of endeavor. (Ans. 21.) In particular, Ferrell's disclosure of indexing, querying, and retrieving content objects in an online network generally relates to Appellant's disclosure of automated processing of multiple items of data. (Ans. 18, 20-21.)

II. ISSUES

1. Has Appellant shown that the Examiner erred in concluding that the combination of Hollingsworth, Ferrel, and Belanger renders independent claim 1 unpatentable? In particular, the issues are whether:

a) Hollingsworth teaches providing a set of predetermined function definitions.

b) Ferrel teaches at least one of said predetermined function definitions defining a function for editing image data.

c) The combination of Ferrel and Belanger teaches automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definitions, wherein transmitting said communication occurs after editing a predetermined number of images.

d) An ordinarily skilled artisan would have found sufficient rationale for the proffered combination.

e) Ferrel is analogous art and can be properly used in the proffered combination.

III. FINDINGS OF FACT

Appellant's Invention

1. Appellant's claimed invention generally relates to automated processing of multiple items of data. In particular, Appellant invented a method and apparatus for automatically transmitting a communication during automated data processing. (Spec. 1, ll. 2-6.)

2. Figure 1 depicts project definition (14) that defines how data from the files in the subdirectory (12) should be processed. (Spec. 8, ll. 6-7.) Conceptually, one way to view the project definition (14) of Figure 1 is that execution proceeds on a module-by-module basis through the project definitions from the source module (21) to the branch module (26), and then to either the action module (31) followed by the destination module (37), or alternatively to the action module (32) followed by the destination module (38). (Spec. 10, ll. 11-18.) Another way to view the project definition (14) is that each of the modules is ready at all times to carry out its respective functions. (Spec. 10, ll. 18-20.) The projection definition (14) may include two or more mutually exclusive sets of modules, which are each referred to as a process. (Spec. 12, ll. 3-5.)

3. Figure 14 depicts that the module area (514) of the screen (501) includes a "source" icon (526), a "branches" icon (527), an "actions" icon (528), and a "destination" icon (529). (Spec. 88, ll. 29-31.) To the right of the column containing areas (513) and (514) is a further column (536), which contains a list, in a standard tree format (537), of available source, branch, action, and destination definitions. (Spec. 89, ll. 3-6.) In this regard, the tree (537) includes nodes (541-544) adjacent to each category of definitions. (Spec. 89, ll. 6-8.)

Hollingsworth

4. Workflow generally relates to the automated procedures where documents, information, or tasks are passed between participants according to a defined set of rules to achieve an overall business goal. (P. 6, ll. 1-2.) Workflow management systems use Build-time functions to define and model the workflow process. (P. 6, l. 26 through Pg. 7, l. 2.) Build-time functions are business processes translated from the real world to formal, computer process definitions by the use of one or more analysis, modeling, and system definition techniques. (P. 7, ll. 10-12.) A process definition comprises a number of activity steps, with associated computer and human operations that invoke rules governing the progression of the process through the various activity steps. (P. 8, ll. 1-2.) The process definition contains all the necessary information about the process to enable it to be executed by software. (P. 12, ll. 25-26.)

5. Workflow technology encompasses a number of different product areas, including image processing, document management, and electronic mail and directories. (P. 9, l. 18 through P. 10, l. 23.) In regards to image processing, once information is captured electronically as image data, it may be passed between different participants and other IT applications, thereby creating a need for workflow functionality. (P. 10, ll. 4-7.)

Ferrell

6. Ferrell discloses a system and method for indexing, querying, and retrieving content objects, including images, in an online network. (Col. 4, ll. 2-4.)

7. Figure 2 depicts a Multimedia Publication System (“MPS”) (100) that includes a set of tools for designing, developing, and viewing multimedia online applications. (Col. 10, ll. 17-20.) A publisher (102) utilizes a computer (180) and a Design software environment (194) to create and publish the title layout (110) and content objects (112). (Col. 12, ll. 20-24.) The Designer (194) includes an image editor (192) that creates and modifies images. (Col. 10, ll. 34-45.)

8. When a publisher creates a page layout and associated content objects, the title layout and content objects are published together and may be downloaded by consumers using the MPS software. (Col. 8, ll. 61-67.) Figure 1 depicts a public storage (120) implemented as a network (122) where the title layout and content objects are released and stored. (Col. 9, ll. 52-58.) In particular, Figure 5 depicts an MPS Caching Object Store (“COS”) server (246) that publishes the title layout and content objects. (Col. 17, ll. 29-32.) A publisher can just publish a content folder having one or more content objects to the COS server (246). (Col. 17, ll. 32-34.) The COS server (246) copies the published title layout and content objects to the Information Retrieval (“IR”) system (398). (Col. 17, ll. 38-40.)

Belanger

9. Belanger generally relates to a computer-implemented method for analyzing, identifying, and comparing images. (Col. 1, ll. 8-10.)

10. Belanger discloses a spider or search engine that can be used to search an electronic network for copies of an identified image. (Col. 8, ll. 58-60.) The spider or search engine includes an alarm or notification feature. (Col. 9, ll. 32-33.) The alarm or notification feature can be conditioned upon the occurrence of a particular event, such as identifying

the total number of images on a site or electronic network, determining the selected characteristics of an image or group of images, and locating and identifying all images at a particular site. (Col. 9, ll. 43-64.)

IV. PRINCIPLES OF LAW

Claim Construction

"[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313 (citations omitted).

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips*, 415 F.3d at 1323.

Obviousness

"On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by

rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness." *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 415 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966)) (citation omitted). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 415, 417.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 416). The Federal Circuit relied in part on the fact that *Leapfrog* had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an

unobvious step over the prior art.” *Id.* at 1162 (citing *KSR*, 550 U.S. at 417-18).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d 977, 987-988 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826 (CCPA 1968) (citation omitted).

In identifying a reason that would have prompted a person of ordinary skill in the relevant field to combine the prior art teachings, the Examiner must show some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR*, 550 U.S. at 418.

V. CLAIM GROUPING

Appellant argues that the combination of Hollingsworth, Ferrel, and Belanger does not render independent claim 1 unpatentable. Appellant does not specifically argue the other rejected claims. In accordance with the provisions of 37 C.F.R. § 41.37(c)(1)(viii), we will consider claims 2 through 10, 12, and 14 as standing or falling with claim 1.

VI. ANALYSIS

Claim 1

Independent claim 1 recites in relevant parts: 1) providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for editing image data; 2) storing a project definition . . . which includes: a plurality of function portions which each correspond to one of said function definition in said set; and 3) wherein transmitting said communication occurs after editing a predetermined number of images.

We first consider the scope and meaning of the terms “*predetermined function definitions*” and “*project definition*,” which must be given their broadest reasonable interpretation consistent with Appellant’s disclosure, as explained in *In re Morris*, 127 F.3d 1048 (Fed. Cir. 1997):

[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

Id. at 1054. *See also In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) (stating that “claims must be interpreted as broadly as their terms reasonably allow.”). Appellant’s Specification states the following:

[Figure 14 depicts that] [t]he modules area 514 of the screen 501 includes a “sources” icon 526, a “branches” icon 527, an “actions” icon 528, and a “destination” icon 529.

(Spec. 88, ll. 29-31; *see also* FF 3; *see also* Supp. App. Br. 3.)

To the right of the column containing areas 513 and 514 is a further column 536, which contains a list, in a standard tree format 537, of

available source, branch, action, and destination definitions. In this regard, the tree 537 includes nodes 541-544 adjacent [sic] each category of definitions.

(Spec. 89, ll. 3-8; *see also* FF 3; *see also* Supp. App. Br. 3.)

FIGURE 1 is a block diagram of a configuration 10 which embodies features of the present inventions, and which includes . . . *a project definition 14 that defines how data from the files in the subdirectory 12 should be processed . . .*

(Spec. 8, ll. 2-7, *see also* FF 2.) (Emphasis added.)

Conceptually, one way to view the project definition 14 of FIGURE 1 is that execution proceeds on a module-by-module basis through the project definitions...from the source module 21 to the branch module 26, and then to either the action module 31 followed by the destination module 37, or alternatively to the action module 32 followed by the destination module 38. Another way to view project definition 14 is that each of the modules is ready at all times to carry out its respective function . . .

(Spec. 10, ll. 11-20; *see also* FF 2.)

A projection definition of the general type shown at 14 in FIGURE 1 may include two or more mutually exclusive sets of modules, which are each referred to as a process.

(Spec. 12, ll. 3-5; *see also* FF 2.)

Upon reviewing Appellant's Specification, we find that the term "*predetermined function definitions*" includes respective source, branch, action, and destination definitions. Further, we find that the term "*project definition*" includes source, branch, action, and destination modules. Therefore, we conclude that the claim term "*project definition*" includes "*predetermined function definitions*," such as source, branch, action, and destination definitions. Additionally, we conclude that the claim term

“*project definition*” may be broadly, but reasonably construed as a process or task for performing a specific function.

As set forth in the Findings of Fact section, Hollingsworth discloses automated procedures, where documents, information, or tasks are passed between participants according to a defined set of rules to achieve an overall business goal. (FF 4.) In particular, Hollingsworth discloses that a process definition comprises a number of activity steps, with associated computer and human operations that invoke rules governing the progression of the process through the various activity steps. (*Id.*) The process definition contains all the necessary information about the process to enable it to be executed by software. (*Id.*) Further, one of the process definitions disclosed in Hollingsworth includes capturing and processing electronically image data. (FF 5.) Therefore, consistent with the broadest reasonable interpretation adopted above, the process definitions that encompass image processing disclosed in Hollingsworth teach processes or tasks for performing a specific function.

Further, we find that Ferrel discloses a system and method for indexing, querying, and retrieving images in a network. (FF 6.) Ferrel discloses a set of tools for designing, developing, and viewing title layouts (110) and content objects (112), including a Designer (194) that contains an image editor (192) for creating and modifying images. (FF 7.) We find that Ferrel teaches a tool for creating and modifying images. In particular, we find that Ferrel’s disclosure of a tool for creating and modifying images, in conjunction with Hollingsworth’s disclosure of various process definitions, including image processing, teaches providing a set of predetermined function definitions which are different, at least one of said predetermined

function definitions defining a function for editing image data, as recited in independent claim 1.

Additionally, we find that Ferrel discloses a publisher that creates a page layout and associated content objects; stores the title layout and content objects; publishes or releases the title layout and content objects to an Information Retrieval system; and allows consumers to download the title layouts and content objects using the associated software. (FF 8.) We find that Ferrel's disclosure of transmitting title layouts and content objects to an Information Retrieval system, in conjunction with allowing a consumer to download title layouts and content objects using the associated software, teaches transmitting a communication. Further, we find that Belanger discloses a computer-implemented method for analyzing, identifying, and comparing images that includes an alarm or notification feature that may be conditioned upon the occurrence of a particular event. (FF 9, 10.) We find that Belanger's disclosure of a notification feature conditioned upon the occurrence of a particular event teaches transmitting a communication in response to a predefined condition. As set forth above, we find that Ferrel teaches a tool for creating and modifying images. In summary, we find that Ferrel's disclosure of a tool for creating images, modifying images, and transmitting a respective communication, in conjunction with Belanger's disclosure of transmitting a communication in response to a predefined condition, teaches wherein transmitting said communication occurs after editing a predetermined number of images, as recited in independent claim 1. It follows that Appellant has not shown that the Examiner erred in finding that the combination of Hollingsworth, Ferrel, and Belanger renders independent claim 1 unpatentable.

Rationale to Combine

As set forth in the Findings of Fact section, Hollingsworth discloses process definitions that define how documents, information, or tasks are passed between participants in order to achieve an overall business goal. (FF 4.) In particular, one of the numerous process definitions disclosed in Hollingsworth includes capturing and processing electronically image data. (FF 5.) Ferrel complements Hollingsworth by disclosing a system and method for indexing, querying, and retrieving images that include a tool for creating and modifying images, and allows respective title layouts and content objects to be transmitted to an information retrieval system. (FF 6, 7, 8.) Further, Belanger complements the combination of Hollingsworth and Ferrel by disclosing a computer-implemented method for analyzing, identifying, and comparing images that include an alarm or notification feature conditioned upon the occurrence of a particular event. (FF 9, 10.) Thus, we find that Hollingsworth, Ferrel, and Belanger disclose prior art elements that perform their ordinary functions to predictably result in a method and apparatus for processing multiple items of data comprising various project definitions, including defining a function for editing images, storing the project definitions, executing the project definitions, and transmitting an electronic message in response to a predefined condition. *See KSR*, 550 U.S. at 418-419.

Analogous Art

Upon reviewing Appellant's Specification, we find that the claimed invention generally relates to automated processing of multiple items of data, and, in particular, transmitting a communication during automated data processing. (FF 1.) We find that Appellant's field of endeavor is processing

and transmitting data. Further, Ferrel discloses a system and method for indexing, querying, and retrieving title layouts and content objects in an online network. (FF 6.) We find that Ferrel is within the same field of endeavor as the claimed invention, because both concern processing and transmitting data.

VII. CONCLUSION OF LAW

Appellant has not shown that the Examiner erred in concluding that the combination of Hollingsworth, Ferrel, and Belanger renders claims 1 through 10, 12, and 14 unpatentable under 35 U.S.C. § 103(a).

VIII. DECISION

We affirm the Examiner's decision to reject claims 1 through 10, 12, and 14 as being unpatentable under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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